

REMARKS

Claims 11-28 are pending in the Application while claims 22 and 28 are withdrawn from consideration as drawn to a non-elected invention. Claims 11-21 and 23-27 stand rejected in the Final Office Action. No claims are amended. Claims 11-28 remain pending.

ELECTIONS/RESTRICTIONS

Claims 22 and 28 are withdrawn from consideration as being directed to a non-elected invention, as detailed in page 2 of the Final Rejection. However, the regulations provide that upon allowance of a generic claim Applicant will be entitled to consideration of claims to additional species. Applicants respectfully submit that claims 11 and 23, from which the withdrawn claims depend, are generic to the non-elected invention. For the reasons discussed below, Applicant believes the generic claims are allowable. Accordingly, Applicants respectfully request the Examiner remove the restriction requirement and rejoin claims 22 and 28.

INFORMATION DISCLOSURE STATEMENT

The Final Rejection states that the Information Disclosure Statement filed 12/21/06 has been placed in the file, but the information referred to therein has not been considered. Applicants appreciate this consideration by the Examiner. For the record, Applicants wish to state that the references cited in the IDS filed December 21, 2006 are no more than cumulative to the cited art of record in this case.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 11-21 and 23-27 stand rejected under 35 U.S.C. § 103(a) as obvious over the Lutkus reference in view of the Whitford Paper. The Examiner maintains her *prima facie* case of obviousness based on a combination of the two references. Further, the Examiner has considered the Declaration filed in December. In § 5 of the Final Rejection, the Examiner states that she does not see convincing proof of unexpected results in the Declaration. Applicants respectfully request reconsideration in light of the following comments.

Experimental results showing superior performance with a chromate free coating are discussed in § 8 and Table 1 of the Declaration. The Examiner refers to this argument and data in the Final Rejection and states that she does not see it as convincing proof of unexpected results. Applicants respectfully request reconsideration of the conclusion in view of other data and evidence offered in the Declaration.

Applicants believe that weight may have been given only to a portion of the Declaration that describes the results with tanged inserts. Applicants believe that, if other portions of the Declaration are re-evaluated and the evidence weighed, a decision should be supported that the surprising results demonstrated in the Declaration overcome the *prima facie* case of obviousness. The Examiner's attention is respectfully drawn to other portions of the Declaration as follows.

At § 6 of the Declaration, Mr. Lutkus states:

“With tangless versus tanged, and with chromate versus chromate free, we have consistently observed differences in performance as discussed herein. Sometimes the differences in performance are rather subtle. But those in my field recognize that even small gains can be important. In practice, even a seemingly small improvement in performance can translate into significant commercial advantages.” *Underlining added for emphasis.*

From the outset, Mr. Lutkus establishes that small, even subtle differences in performance can be significant and commercially valuable.

Then in § 7, Mr. Lutkus states that tangless inserts performed better in the prevailing torque test when the coating was chromate free. At § 8, Mr. Lutkus states that results with tanged inserts showed an improvement that was “more subtle but nevertheless real and as significant” as that shown with the tangless inserts. These “more subtle” results are presented in Table 1 and are the data referred to in the Final Rejection.

Continuing at § 11, Mr. Lutkus states that when the test is carried out on tangless inserts coated with the chromate free coatings as currently claimed, the results show “even more differences than with the tanged inserts”. He continues that with tangless inserts, “more of the test samples show movement of the insert, and more of the test samples exhibit torque that is outside of specification than are shown in Table 1 for the tanged inserts.” The conclusion is easily supported that Mr. Lutkus considers performance with both the tanged and tangless to be significantly improved when tested with the chromate free coating.

On the basis of the data shown for the tanged inserts and the results discussed for the tangless inserts, Mr. Lutkus states at § 12 that the inserts coated with the chromate free coatings exhibit a “surprising improvement” over inserts coated with the chromate containing coating. He observes that the improvement is more noticeable when the test is run on tangless inserts. He further states that the observation of the improved results was “completely unexpected”. Applicants respectfully submit the Declarant’s position as inventor of the improvement as well as of the reference against which the improvement is measured entitles his sworn statement to be given due weight.

Thus, when the Declaration is read as a whole, it is seen that Mr. Lutkus has demonstrated that:

- even subtle or small improvements in performance are significant in his field (§ 6);
- chromate free coatings produce a noticeable improvement when tested on tanged inserts, (§ 8 and Table 1);
- the chromate free coating on tangless inserts results in a more noticeable improvement than on the tanged (§ 11); and
- he considers the improved performance of the chromate free coating to be a “surprising improvement” that was “completely unexpected” (§ 12).

Applicants respectfully submit that if these points are considered along with the rest of the Declaration, and with due weight given to Declarant’s knowledge of both the invention and the cited art, a convincing showing of unexpected results or unexpected improvements has been made, which should overcome the *prima facie* case of obviousness built on the combination of the cited references.

For the above reasons, Applicants respectfully request reconsideration of the Final Rejection, removal of the pending Restriction Requirement and the rejoining of the withdrawn claims 22 and 28, as discussed above.

CONCLUSION

For the reasons discussed above, Applicants believe that claims 11-28 are in an allowable condition and respectfully request an early Notice of Allowance. In the alternative, Applicants respectfully request an Advisory Action advising whether the arguments can be considered at

this time. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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